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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,310	08/21/2001	G. David Jang	S63.2-10078	8078

490 7590 11/27/2006

VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER

PREBILIC, PAUL B

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/934,310	Applicant(s) JANG, G. DAVID	
	Examiner Paul B. Prebilic	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34,35,37,42-45 and 47-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34,35,37,42-45 and 47-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9-18-06 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The language requiring a tapered flow path appears to lack antecedent basis from the specification.

Drawings

The drawings were received on September 18, 2006. These drawings are approved.

Claim Objections

Claim 42 is objected to because of the following informalities:

With regard to claim 42, on line 10, after "diameter", a comma should be inserted to make the language clearer. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 47 and 48 are rejected under 35 U.S.C. 102(e) as anticipated by Goicoechea et al (US 5,609,627) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Goicoechea et al (US 5,609,627) alone. Goicoechea anticipates the claim language where the annular elements as claimed are the hoops (20) of Goicoechea; see Figure 2a and Figure 1a as well as column 9, lines 1-12. The tapered configuration as claimed is met by the frustoconical part (14) of Goicoechea, and the different flexibilities as claimed are inherent since the same diameter wire is used to make the entire structure such that the smaller diameter portions would inherently have less flexibility than the larger diameter portions. The stent "cut from a tube" product-by-process limitation is met by Goicoechea since the stent of Goicoechea could be cut from a longer legged stent; see MPEP 2113 that is incorporated herein by reference.

Alternatively, the limitation "cut from a tube" at most would result in only a slight difference in structure such that the claim language would have been considered clearly obvious to an ordinary artisan.

Claims 34, 35, 37, 42-45 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lau et al (US 5,421,955) in view of Alt et al (US 5,843,117) or Limon et al (US 6,027,526). Lau discloses tapering a stent that has the same number of struts in each segment and altering the radial stiffness of the stent by varying the amplitude of the undulating annular segments; see the figures and column 4, lines 48-53 and column 5, line 61 to column 6, line 2. Since the taper is to match the blood vessel and since blood vessels taper, along their lengths, from a larger diameter to a smaller diameter,

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the Examiner asserts that it would have been *prima facie* obvious to taper the Lau stent in this manner. Also, Lau suggests varying the radial flexibility (i.e. radial stiffness) but not specifically from one end to another. However, Alt teaches that it was known to vary the radial thickness and stiffness with struts of substantially the same circumferential width; see Figure 11 and column 18, lines 62 to column 19, line 17. Likewise, Limon teaches that it was known to do the same but from one end to another; see particularly Figure 18 and column 7, lines 24-38. Therefore, it is the Examiner's position that it would have been obvious to vary the radial flexibility for the same reasons that Limon or Alt does the same.

Response to Arguments

Applicant's arguments filed September 18, 2006 have been fully considered but they are not persuasive.

With regard to the specification objection, the Applicant referred to various pages of the specification, however, the Examiner could not find clear support thereon. For this reason, the objection has been maintained. The Examiner suggests inserting the actual language of the claim into the specification in order to overcome this objection.

In response to applicant's argument that the references fail to show certain features of applicant's invention (specifically, claims 48 and 49 where the previous rejection has been maintained), it is noted that the features upon which applicant relies (i.e., the greatest diameter annular element having no more interconnected struts than the narrowest diameter annular element) are not recited in the claims 48 and 49.

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Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

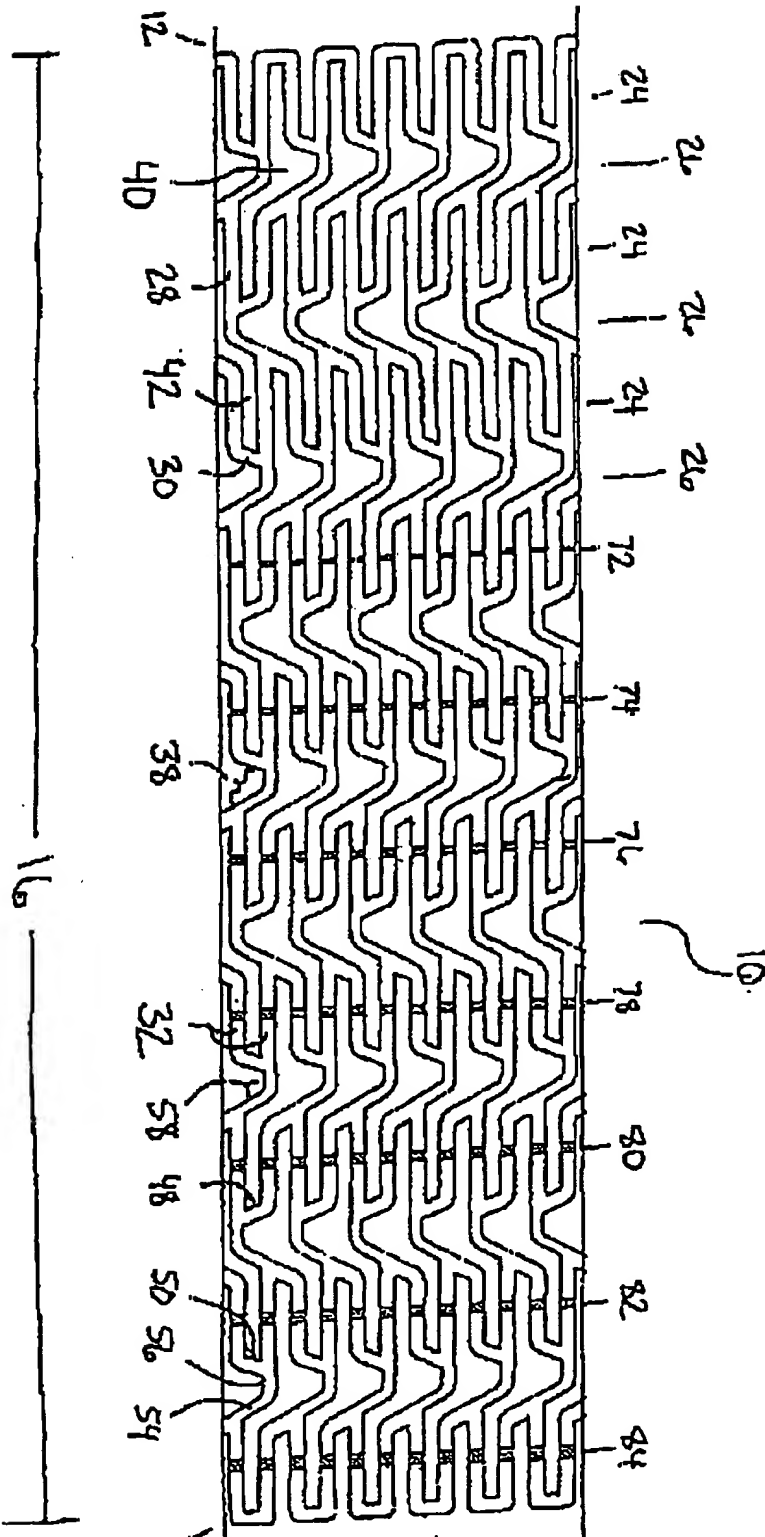
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Paul Prebilic', with a stylized flourish at the end.

Paul Prebilic
Primary Examiner
Art Unit 3738

REPLACEMENT DRAWING

FIG. 5A



Approved
for
entry
PBP
11/20/06

REPLACEMENT DRAWING

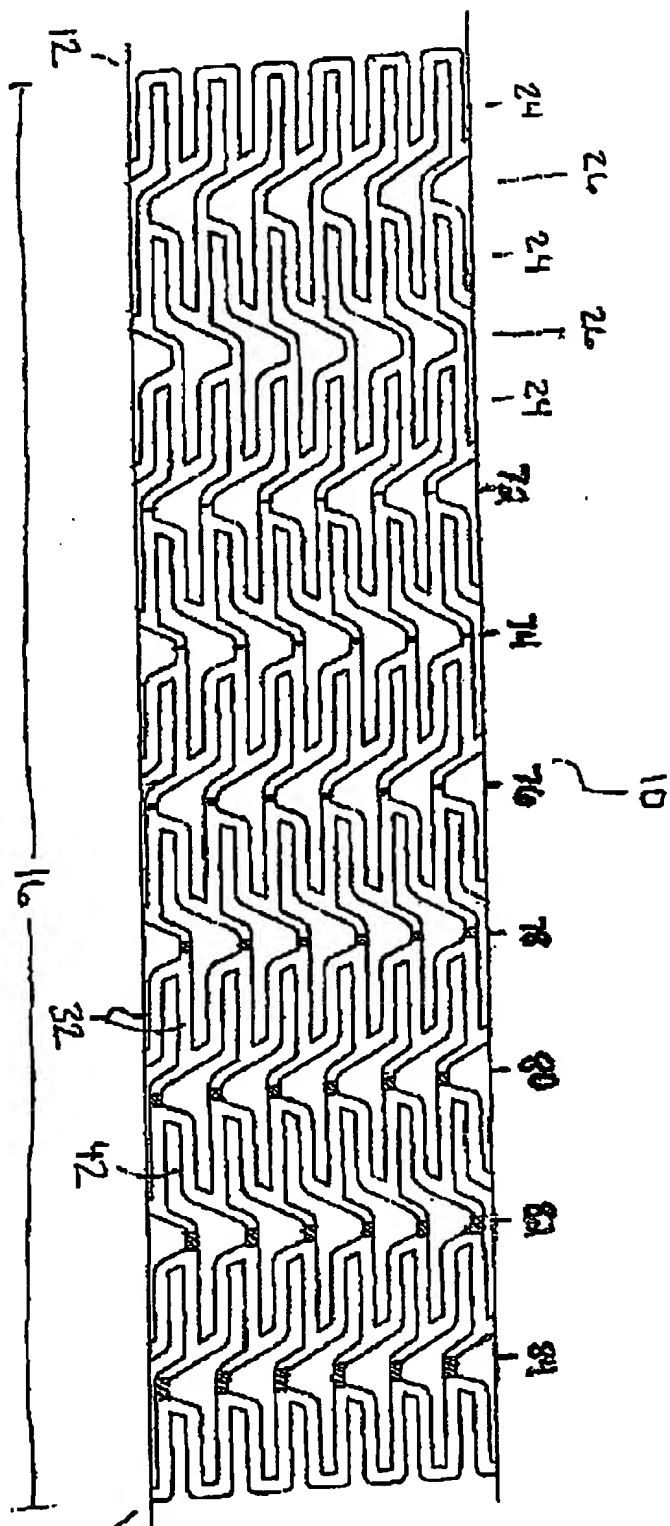


FIG. 5B

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REPLACEMENT DRAWING

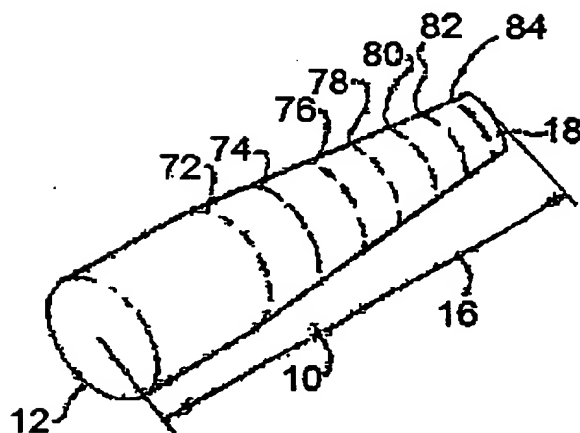


FIG. 5C

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